

#### **IV. REMARKS**

##### **Status of the Claims**

Claims 1, 7, and 13 are amended. Claims 62-64 are added. Claims 1,3-7, 9-11,13,16,19,21-37 and 44-64 are presented for further consideration.

##### **Summary of the Office Action**

Claims 1,7 and 13 stand rejected under 35USC103(a) on the basis of the cited reference Sanemitsu, U.S. Patent No. 5,708,853, in view of the teaching of Koppa, U.S. Patent No. 6,088,746.

Claims 3-5,9-11,16,21-29,31-37, and 44-61 stand rejected under 35USC103(a) on the basis of the combined teachings of the references Sanemitsu and Koppa and further in view of the reference Endsley, U.S. Patent No. 6,005,613.

Claim 6 stands rejected under 35USC103(a) on the basis of the reference Sanemitsu in view of the teachings of Koppa and Endsley and further in view of the disclosure of Miyake, U.S. Patent No. 6,400,413.

Claims 19 and 30 stand rejected under 35USC103(a) based on the reference Sanemitsu in view of the teachings of Koppa and further in view of the disclosure of Hsieh, et al, U.S. Patent No. 5,969,750. The Examiner is respectfully requested to reconsider his rejection in view of the following remarks.

Applicants have amended the Abstract to conform to the proper form.

##### **Discussion of the Cited References**

In the Official Action, the Examiner rejects all the currently pending independent and dependent claims primarily on the

basis of the combined teachings of the cited references Sanemitsu and Köppä.

Sanemitsu's patent relates to an IC card including an image input device and an acoustic input device (see abstract) which can be inserted into a corresponding IC card slot (column 1, lines 52 to 55) of a computer or personal assistant device in order to provide that device with image and sound transmission capabilities. In at least some embodiments, Sanemitsu's IC card can be inserted into a notebook-sized computer in such a way that it is completely enclosed by the structure of the computer (see Figures 3 and 4 together with their corresponding descriptions from column 3, line 60 to column 4, line 19). In these embodiments, holes are provided in the housing of the computer in locations corresponding to the positions of the image input device and acoustic input device of the IC card so that light and sound may be received by the image and acoustic input devices in the IC card.

Köppä's patent, on the other hand, relates in general to expansion cards for use with electronic devices such as mobile telephones or computers. As explained in column 1 between lines 11 and 31, such expansion cards are connected to the host device with a connector and are typically implemented according to a standard (e.g. the PCMCIA standard), which defines the function of each pin of the connector. Köppä's patent presents a mechanism enabling an operating mode of an IC card to be set by supplying a signal via a pin of a standard connector that is usually used for another purpose according to the standard (see, for example, column 3, lines 43 to 47, column 4 line 66 to column 5, line 19 and column 5, Table 1). As part of the disclosure of one of Köppä's embodiments, it is mentioned that data is transferred in serial form between the expansion card and the electronic device to which it is connected (column 7, lines 25 to 34).

In his rejections of the independent claims 1,7, and 13, the Examiner states that it would have been obvious to a person of ordinary skill in the art to combine the teachings of Sanemitsu with those of Köppä in order to arrive at the invention claimed in the present application. However, the Applicant respectfully disagrees with this view since both Sanemitsu and Köppä relate to the structure (Sanemitsu) and data transfer characteristics (Köppä) of an IC/expansion card that is connected to a host device.

The claims of the present invention, on the other hand, relate to the transmission of image information between a camera module and an electronic device, where the camera module is integrated in the electronic device as a component of the electronic device (see newly amended claim 1, for example). Neither Sanemitsu's IC card nor Köppä's expansion card are integrated in their respective host devices as a component of the host device, rather they are peripheral/additional devices that can be connected to the host and used in connection with the host device. They are separate devices, not integrated components of the host. Therefore even a combination of Köppä with Sanemitsu, as suggested by the Examiner, cannot possibly render the present invention obvious. At least for this reason, the Applicant considers that the claims as newly amended are patentably distinct from the teachings of Sanemitsu and Köppä when considered either in isolation or in combination. The Examiner has failed to support a prima facie case of obviousness.

According to basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the

references must be viewed without the benefit of hindsight. (See MPEP sections 706.02(a) and 2141. Applicant submits that the modification of the teachings of Sanemitsu and Koppa in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art. There is no indication that such a modification would be feasible or desirable.

None of the remaining references, cited by the Examiner, remedy the deficiencies of the disclosures of Sanemitsu and Koppa as described above. Therefore the above arguments also apply to the rejections of the dependent claims.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$1244.00 is enclosed for a three month extension of time and additional claim fees. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.